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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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105/0046,661

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SATTO

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58000.240C II

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LM12/0704

EXAMINER

SHYADIAN, H

ART UNIT

PAPER NUMBER

376.6

DATE MAILED:

02/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No 08/846,661	Applicant(s) SAITO
	Examiner Hrayr A. Sayadian	Group Art Unit 2766

☒ Responsive to communication(s) filed on Sep 22, 1997

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

GENERAL

1. Applicant should note that the number of the Art Unit, examining this Application, has changed to 2766.

To avoid delays in prosecuting this Application due to mis-routing within the USPTO, Applicant should use the new Art Unit number in future correspondence with the USPTO.

2. Receipt, at the USPTO on 9-22-1997, of the declaration and power of attorney for patent application is acknowledged.

REJECTIONS BASED ON PRIOR ART

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the bases for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-4 are rejected under 35 U.S.C. § 102(b,e) as being anticipated by Matsumoto ('299) [hereinafter Matsumoto].
5. With respect to claim 1, Matsumoto teaches an original data content comprising a data object (see, e.g., lines 9-10 of column 3); an edited data content comprising the data object and an editing scenario describing editing details of the data object (see, e.g., lines 17-19 of column 3); a data content dealing system comprising data content dealing center (the mail server, element 20 of Fig. 1A), a database (inherent in the data base within the

mail server), wherein the data content dealing management center further comprises a key management center, a data content dealing management center, and an editing scenario dealing management center (all inherently being the mail server). With respect to the further recitations in claim 1, the limitations recite step element, which step elements are functional recitations that do not provide structural limitations on the limitations already recited in this system claim.

With respect to claim 2, the mail center in Matsumoto stores a data contains an editing scenario comprising the editing scenario data base.

With respect to claim 3, the further limitation recites a step element, which step element is a functional recitation that does not provide structural limitations on the limitations already recited in this system claim.

With respect to claim 4, please see the analysis of claim 1, which analysis applies other than replacing editing scenario market management center (in claim 4) for editing scenario dealing management center (in claim 1).

Because it is unclear whether elements of the claims, as interpreted, have priority to the parents or the new matter introduced to form this CIP application, this rejection is presented as either 102(b) or 102(e).

REJECTIONS BASED ON DOUBLE PATENTING

6. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper extension of duration of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2c 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

7. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending parent application Serial No. 08/882,909 (which is a continuation of 08/549,270, now abandoned) and copending parent application serial no. 08/536,747). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of said copending parent applications anticipate a data management center comprising a data center and a key center.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-4 are rejected under the judicially created doctrine of double patenting over claims of copending parent application Serial No. 08/733,504 and parent U.S. Pat. No. 5,646,999, since the claims, if allowed, would improperly extend the "right to exclude" to be granted if the parents are allowed.

The subject matter claimed in the instant application is fully disclosed in said parent application and parent patent and is covered by them since they and this application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application to be prosecuted under said parent application and parent patent. See M.P.E.P. § 804.

EXAMINER'S SUGGESTION

9. To insure proper consideration of recited functional language as limiting the claimed invention, Examiner suggests either (1) that the system claims be converted to method claims or (2) that means for language be used in the system claims (for example recite "means for generating a secret key, means for storing said secret key, and means for transferring of said secret key, said three immediately preceding means in said key management center" instead of the text in lines 16-17 in 69, which lines recite part of claim 1).

TIME PERIOD FOR RESPONSE

10. A shortened statutory period for response to this action is set to expire **THREE MONTHS** from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). See 37 C.F.R. § 1.136 for extension of Time Period for Response.

INFORMATION ON HOW TO CONTACT THE USPTO

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hrayr A. Sayadian whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday through Friday, from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Gail Hayes, can be reached on (703) 305-9711. The fax phone number for Technology Center 2700 is (703) 308-9051 or 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 305-3800 or 305-4700.

Hrayr A. Sayadian
9-29-1998



GAIL O HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2700